

## REMARKS

Applicant notes the allowance of Claim 1 and the indicated allowability of Claims 5 and 7-10. Claims 2, 3, 6, 23, and 24 – 27 stand rejected as obvious over the patent to Debley et al. (U.S. Patent No. 5,529,671). Claims 4 and 20 stand rejected as obvious over Debley et al. in view of Kelley et al. (U.S. Patent No. 4,101,925).

### Not all claim limitations taught or suggested

All claim limitations must be taught or suggested in order to establish a *prima facie* case of obviousness. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner presently relies on a presumption stated in an earlier Office Action dated October 8, 2004, namely that the term “evaporator” that is present in each of the independent claims 2, 23, 24 and 25 may be construed to mean “target” of an ion gun. The Examiner has not shown, and Debley et al. is silent on, evaporation. Rather, Debley et al. discloses *sputtering and polishing* using neutral ion guns and does not teach or suggest *evaporation*. As such, a *prima facie* case of obviousness has not been established and the rejections based thereon should be withdrawn.

Furthermore, in the instant specification, the term “evaporator” is the general term used to refer to the specific embodiment of an electron beam gun 10. Indeed, at page 8, line 13, the specification refers to “evaporators” with the reference number 10 (see figure 2A). Further, at page 9, line 13, “. . .before evaporation from that gun 10 is initiated”. The broadest construction of the specification cannot support an interpretation that “evaporator” could exclude a gun, as incorrectly concluded by the Examiner. As such,

the Examiner's conclusion is drawn without merit and any rejection based on Debley et al. should be withdrawn.

No motivation to modify

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221USPQ 1125 (Fed. Cir. 1984).

The Examiner states at page 3 of the present Office Action, "Arrangement of parts such that the location is laterally spaced as opposed to longitudinally spaced would have been obvious with a reasonable expectation of success, as the mode of operation is not changed." However, target 51 in Debley et al. is first cleaned in a presputter process (col 8, ln 9-13) and then rotated to expose a material on target 51 to ion gun 49. If target 51 were laterally displaced, then it would be out of the beam path of ion gun 49 and no presputtering process could occur without reconfiguring the apparatus as a whole.

Furthermore, throughout the Debley et al. disclosure, it is clear that the use of ion beams and their angle of incidence are important variables to the disclosure. Indeed, the first sentence in the abstract of Debley et al. is: "The invention uses an ion beam to polish a rotatable substrate from an oblique angle . . . to upgrade the quality of substrates". However, the proposed modification of lateral spacing would require an adaptation to compensate for the angle of incidence of the ion beam gun 49, if the same functionality of Debley et al. is to be maintained.

As such, the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. No suggestion or motivation to make the proposed modification exists. Reconsideration and withdrawal of the obviousness rejections based thereon is solicited.

No basis to apply *In re Japikes* 86 USPQ 70 or *In re Rose* 105 USPQ 237

The Examiner presently relies on *In re Japikes* 86 USPQ 70 and *In re Rose* 220 F.2d 459, 105 USPQ 237 to assert that a rearrangement of parts, as long as the same function is performed, would have been obvious.

As to *In re Japikes*, the claims therein were directed to a hydraulic power press that read on the prior art except for the positioning of the start switch. Relocating the position of a start switch is not similar in any way to reconfiguring target materials and beam guns as discussed in the previous paragraphs. As such, *In re Japikes* is not relevant here.

As to *In re Rose*, the claims at issue were directed to a lumber package "...of appreciable size and weight requiring handling by a lift truck" which read on prior art lumber packages able to be lifted by hand. The facts and the decision of the court related to patentability when a prior art device is merely resized / rescaled. There is no issue of size or proportion in the present case. As such, *In re Rose* is not relevant here.

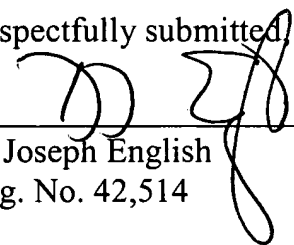
Thus, the Examiner has shown no legal basis for his rejection. Reconsideration and withdrawal of the rejection is solicited.

## CONCLUSION

The Debley et al patent does not anticipate or suggest, make obvious or is even relevant, to the claims of the present invention. Reconsideration and withdrawal of the rejection of independent Claims 2, 23, 24 and 25 is solicited. Claims depending from the independent claims are deemed patentable at least by virtue of their dependence, notwithstanding their additional patentable limitations.

The application is in condition for allowance. A further and favorable action and allowance of all claims is solicited. Should the Examiner find these arguments non-persuasive, an interview with the Examiner is hereby requested.

Respectfully submitted,



---

D. Joseph English  
Reg. No. 42,514

DUANE MORRIS LLP  
1667 K Street, N.W., Suite 700  
Washington, D.C. 20006  
Telephone: (202) 776-7800  
Telecopier: (202) 776-7801

Dated: June 6, 2005